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10/564,803	11/29/2006	Dean Thetford	3339-01	3395

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EXAMINER	
PEPITONE, MICHAEL F	

ART UNIT	PAPER NUMBER
1796	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/564,803	THETFORD, DEAN	
	Examiner	Art Unit	
	MICHAEL PEPITONE	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/13/06*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☒ Claim(s) *12 and 13* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/13/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 12-13 is objected to because of the following informalities: Formula 1 has been recited in several claims, wherein W is present in an amount from zero to v. Claim 12 has W present in an amount from 1 to v. Suggest renaming to Formula 1b {claim 12} and Formula 1c {claim 13}. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-12: Formula 1 contains the residue W_{0-v} which would yield a negative value for W. Accordingly, dependent claims 2-9 are indefinite. For the purpose of examination, W_{0-v} was interpreted as W present in an amount from zero to v.

Claim 3 recites the limitation "Y is C_{3-4}-alkyleneoxy" in line 1; and "$(Y)_x$ may contain ethyleneoxy" in line 2. Ethyleneoxy is outside the range of a C_{3-4}-alkyleneoxy, therefor claim 3 is indefinite.

Claim 14 recites the limitation "formula 1" in line 2. There is insufficient antecedent basis for this limitation in the claim. For the purpose of examination, formula 1 was interpreted as formula 2.

Claim 14 recites the limitation "the chain RO-$(Y)_x$-T-NH-A-" in line 7. There is insufficient antecedent basis for this limitation in the claim. For the purpose of examination, the definitions of RO-$(Y)_x$-T-NH-A- from claim 1 was used.

Claim 15 recites the limitation "formula 1" in line 3. There is insufficient antecedent basis for this limitation in the claim. For the purpose of examination, formula 1 was interpreted as formula 2a.

Claim 15 recites the limitation "q is from 2 to 2000" in line 9; "q and s are positive integers greater than zero; and q+s is from 2 to 2000" in lines 15-16. It is unclear how q+s is from 2 to 2000 {with s > 0 and q = 2 to 2000}, therefor the claim is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sung (US 4,689,051).

Regarding claims 1-2: Sung teaches a composition comprising an additive prepared by reacting a mono primary etheramine, a dibasic acid anhydride, and an N-alkyl alkylene diamine

(1:55-65; 4:14-52); middle distillate fuel {organic liquid} (1:10-20); and sediment {particulate solid} (1:10-20; 6:12-61).

Regarding claim 3: Sung teaches alkyl polyoxyethylene polyoxypropylene amines [JEFFAMINE-M] {x = 0 to 19} (2:2-56).

Regarding claim 4: Sung teaches the additive is prepared form maleic anhydride (3:23-41); resulting in a residue of a 1,4-butanedoic acid {succinic acid residue} (4:45-53).

Regarding claim 6: Sung teaches middle distillate fuel {organic liquid} [instant claim 6] (1:10-20; 5:63-6:5).

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Sung (US 4,689,051).

Regarding claim 10: Sung teaches a composition comprising an additive prepared by reacting a mono primary etheramine, a dibasic acid anhydride, and an N-alkyl alkylene diamine (1:55-65; 4:14-52); middle distillate fuel {organic liquid} (1:10-20); and sediment {particulate solid} (1:10-20; 6:12-61).

Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Sung (US 4,689,051).

Regarding claim 13: Sung teaches a composition (1:55-65; 4:14-52) prepared by reacting a mono primary etheramine (2:2-56), a dibasic acid anhydride (3:23-41), and N-alkyl alkylene diamine (2:58-3:6).

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Thetford *et al.* (US 6,197,877).

Regarding claim 14: Thetford *et al.* teaches a composition comprising polymeric dispersant (1:1-7) that is polyallylamine chain linked to a poly(oxyalkylenecarbonyl) chain (2:8-30; 2:58-3:18); pigment {particulate solid} (12:23-50); and solvents {organic medium} (11:1-45).

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Thetford *et al.* (US 6,197,877).

Regarding claim 15: Thetford *et al.* teaches a composition comprising polymeric dispersant (1:1-7) that is polyallylamine chain linked to a poly(oxyalkylenecarbonyl) chain (2:58-3:18); pigment {particulate solid} (12:23-50); and solvents {organic medium} (11:1-45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over He (US 2002/0169251), in view of Erdman (US 4,747,971) or Huber *et al.* (US 2005/0120911).

Regarding claims 1-3: He teaches a composition comprising polymeric dispersant that is a condensation product of a polyester, polyamine, and an anhydride (¶ 7-9; 32, 35); wherein the

polyesters include monoalkyl acid chain terminating groups (¶ 9, 36-37); the polyamines are derived from polyalkylpolyamine, polyalkyleneimine, and polyallylamines (¶ 10-16); the anhydrides include 5-6 member ring anhydrides (¶17-19); pigments {particulate solid} (¶ 40, 44); and solvents {organic medium} (¶45).

He does not disclose a polyamine containing alkyleneoxy repeat units. However, Erdman teaches amine-containing dispersants {abstract} prepared from polyamines (2:60-3:64), including polyoxyalkylene polyamines {JEFFAMINEs} [instant claims 1-3] (3:31). He and Erdman are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene polyamines {JEFFAMINEs}, as taught by Erdman in the invention of He, and would have been motivated to do so since Erdman suggests that such polyamines are chemical equivalents (3:28-31), and is an equivalent alternative means of providing amine-containing dispersants.

Alternatively, He does not disclose a polyamine containing alkyleneoxy repeat units. However, Huber *et al.* teaches amine-containing dispersants (¶ 7) prepared from polyoxyalkylene amines [instant claims 1-3] (¶ 7, 14). He and Huber *et al.* are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene amines, as taught by Huber *et al.* in the invention of He, and would have been motivated to do so since Huber *et al.* suggests that such polyoxyalkylene amines provide dispersants provides reduced viscosity and increased gloss when used to formulate printing inks (¶ 10-11, 16).

Regarding claim 4: He teaches succinic anhydride (¶ 32-34).

Regarding claim 5: He teaches polyethyleneimine (¶ 27).

Regarding claims 6-8: He teaches solvents {organic liquid} [instant claims 6 and 8] (¶ 40, 45, Table 1) and molten plastics [instant claim 7] (¶ 40, 45).

Regarding claim 9: He teaches pigments (¶ 40, 44).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over He (US 2002/0169251), in view of Erdman (US 4,747,971) or Huber *et al.* (US 2005/0120911).

Regarding claim 10: He teaches a composition comprising polymeric dispersant that is a condensation product of a polyester, polyamine, and an anhydride (¶ 7-9; 32, 35); wherein the polyesters include monoalkyl acid chain terminating groups (¶ 9, 36-37); the polyamines are derived from polyalkylpolyamine, polyalkyleneimine, and polyallylamines (¶ 10-16); the anhydrides include 5-6 member ring anhydrides (¶17-19); pigments {particulate solid} (¶ 40, 44); and solvents {organic medium} (¶45); wherein the dispersant is milled with the pigment (¶44).

He does not disclose a polyamine containing alkyleneoxy repeat units. However, Erdman teaches amine-containing dispersants {abstract} prepared from polyamines (2:60-3:64), including polyoxyalkylene polyamines {JEFFAMINEs} (3:31). He and Erdman are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene polyamines {JEFFAMINEs}, as taught by Erdman in the invention of He, and would have been motivated to do so since Erdman

suggests that such polyamines are chemical equivalents (3:28-31), and is an equivalent alternative means of providing amine-containing dispersants.

Alternatively, He does not disclose a polyamine containing alkyleneoxy repeat units. However, Huber *et al.* teaches amine-containing dispersants (¶ 7) prepared from polyoxyalkylene amines (¶ 7, 14). He and Huber *et al.* are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene amines, as taught by Huber *et al.* in the invention of He, and would have been motivated to do so since Huber *et al.* suggests that such polyoxyalkylene amines provide dispersants provides reduced viscosity and increased gloss when used to formulate printing inks (¶ 10-11, 16).

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over He (US 2002/0169251), in view of Erdman (US 4,747,971) or Huber *et al.* (US 2005/0120911).

Regarding claim 11: He teaches a composition {ink (¶ 40)} comprising polymeric dispersant that is a condensation product of a polyester, polyamine, and an anhydride (¶ 7-9; 32, 35); wherein the polyesters include monoalkyl acid chain terminating groups (¶ 9, 36-37); the polyamines are derived from polyalkylpolyamine, polyalkyleneimine, and polyallylamines (¶ 10-16); the anhydrides include 5-6 member ring anhydrides (¶ 17-19); pigments {particulate solid} (¶ 40, 44); and solvents {organic medium} (¶ 45); wherein the dispersant is milled with the pigment (¶44); and resins and/or crosslinking agents {binder} (¶ 40-43).

He does not disclose a polyamine containing alkyleneoxy repeat units. However, Erdman teaches amine-containing dispersants {abstract} prepared from polyamines (2:60-3:64), including polyoxyalkylene polyamines {JEFFAMINEs} (3:31). He and Erdman are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene polyamines {JEFFAMINEs}, as taught by Erdman in the invention of He, and would have been motivated to do so since Erdman suggests that such polyamines are chemical equivalents (3:28-31), and is an equivalent alternative means of providing amine-containing dispersants.

Alternatively, He does not disclose a polyamine containing alkyleneoxy repeat units. However, Huber *et al.* teaches amine-containing dispersants (¶ 7) prepared from polyoxyalkylene amines (¶ 7, 14). He and Huber *et al.* are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene amines, as taught by Huber *et al.* in the invention of He, and would have been motivated to do so since Huber *et al.* suggests that such polyoxyalkylene amines provide dispersants provides reduced viscosity and increased gloss when used to formulate printing inks (¶ 10-11, 16).

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over He (US 2002/0169251), in view of Erdman (US 4,747,971) or Huber *et al.* (US 2005/0120911)..

Regarding claim 12: He teaches a composition comprising polymeric dispersant that is a condensation product of a polyester, polyamine, and an anhydride (¶ 7-9; 32, 35); wherein the polyesters include monoalkyl acid chain terminating groups (¶ 9, 36-37); the polyamines are derived from polyalkylpolyamine, polyalkyleneimine, and polyallylamines (¶ 10-16); the anhydrides include 5-6 member ring anhydrides (¶17-19).

He does not disclose a polyamine containing alkyleneoxy repeat units. However, Erdman teaches amine-containing dispersants {abstract} prepared from polyamines (2:60-3:64), including polyoxyalkylene polyamines {JEFFAMINEs} (3:31). He and Erdman are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene polyamines {JEFFAMINEs}, as taught by Erdman in the invention of He, and would have been motivated to do so since Erdman suggests that such polyamines are chemical equivalents (3:28-31), and is an equivalent alternative means of providing amine-containing dispersants.

Alternatively, He does not disclose a polyamine containing alkyleneoxy repeat units. However, Huber *et al.* teaches amine-containing dispersants (¶ 7) prepared from polyoxyalkylene amines (¶ 7, 14). He and Huber *et al.* are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene amines, as taught by Huber *et al.* in the invention of He, and would have been motivated to do so since Huber *et al.* suggests that such

polyoxyalkylene amines provide dispersants provides reduced viscosity and increased gloss when used to formulate printing inks (¶ 10-11, 16).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over He (US 2002/0169251), in view of Erdman (US 4,747,971) or Huber *et al.* (US 2005/0120911)..

Regarding claim 13: He teaches a composition comprising polymeric dispersant that is a condensation product of a polyester, polyamine, and an anhydride (¶ 7-9; 32, 35); wherein the polyesters include monoalkyl acid chain terminating groups (¶ 9, 36-37); the polyamines are derived from polyalkylpolyamine, polyalkyleneimine, and polyallylamines (¶ 10-16); the anhydrides include 5-6 member ring anhydrides (¶17-19).

He does not disclose a polyamine containing alkyleneoxy repeat units. However, Erdman teaches amine-containing dispersants {abstract} prepared from polyamines (2:60-3:64), including polyoxyalkylene polyamines {JEFFAMINEs} (3:31). He and Erdman are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene polyamines {JEFFAMINEs}, as taught by Erdman in the invention of He, and would have been motivated to do so since Erdman suggests that such polyamines are chemical equivalents (3:28-31), and is an equivalent alternative means of providing amine-containing dispersants.

Alternatively, He does not disclose a polyamine containing alkyleneoxy repeat units. However, Huber *et al.* teaches amine-containing dispersants (¶ 7) prepared from polyoxyalkylene amines (¶ 7, 14). He and Huber *et al.* are analogous art because they are

concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene amines, as taught by Huber *et al.* in the invention of He, and would have been motivated to do so since Huber *et al.* suggests that such polyoxyalkylene amines provide dispersants provides reduced viscosity and increased gloss when used to formulate printing inks (¶ 10-11, 16).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over He (US 2002/0169251), in view of Erdman (US 4,747,971) or Huber *et al.* (US 2005/0120911)..

Regarding claim 14: He teaches a composition comprising polymeric dispersant that is a condensation product of a polyester, polyamine, and an anhydride (¶ 7-9; 32, 35); wherein the polyesters include monoalkyl acid chain terminating groups (¶ 9, 36-37); the polyamines are derived from polyalkylpolyamine, polyalkyleneimine, and polyallylamines (¶ 10-16); the anhydrides include 5-6 member ring anhydrides (¶17-19); pigments {particulate solid} (¶ 40, 44); and solvents {organic medium} (¶45); wherein the dispersant is milled with the pigment (¶44).

He does not disclose a polyamine containing alkyleneoxy repeat units. However, Erdman teaches amine-containing dispersants {abstract} prepared from polyamines (2:60-3:64), including polyoxyalkylene polyamines {JEFFAMINEs} (3:31). He and Erdman are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene polyamines {JEFFAMINEs}, as taught

by Erdman in the invention of He, and would have been motivated to do so since Erdman suggests that such polyamines are chemical equivalents (3:28-31), and is an equivalent alternative means of providing amine-containing dispersants.

Alternatively, He does not disclose a polyamine containing alkyleneoxy repeat units. However, Huber *et al.* teaches amine-containing dispersants (¶ 7) prepared from polyoxyalkylene amines (¶ 7, 14). He and Huber *et al.* are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene amines, as taught by Huber *et al.* in the invention of He, and would have been motivated to do so since Huber *et al.* suggests that such polyoxyalkylene amines provide dispersants provides reduced viscosity and increased gloss when used to formulate printing inks (¶ 10-11, 16).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over He (US 2002/0169251), in view of Erdman (US 4,747,971) or Huber *et al.* (US 2005/0120911)..

Regarding claim 15: He teaches a composition comprising polymeric dispersant that is a condensation product of a polyester, polyamine, and an anhydride (¶ 7-9; 32, 35); wherein the polyesters include monoalkyl acid chain terminating groups (¶ 9, 36-37); the polyamines are derived from polyalkylpolyamine, polyalkyleneimine, and polyallylamines (¶ 10-16); the anhydrides include 5-6 member ring anhydrides (¶17-19); pigments {particulate solid} (¶ 40, 44); and solvents {organic medium} (¶45); wherein the dispersant is milled with the pigment (¶44).

He does not disclose a polyamine containing alkyleneoxy repeat units. However, Erdman teaches amine-containing dispersants {abstract} prepared from polyamines (2:60-3:64), including polyoxyalkylene polyamines {JEFFAMINEs} (3:31). He and Erdman are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene polyamines {JEFFAMINEs}, as taught by Erdman in the invention of He, and would have been motivated to do so since Erdman suggests that such polyamines are chemical equivalents (3:28-31), and is an equivalent alternative means of providing amine-containing dispersants.

Alternatively, He does not disclose a polyamine containing alkyleneoxy repeat units. However, Huber *et al.* teaches amine-containing dispersants (¶ 7) prepared from polyoxyalkylene amines (¶ 7, 14). He and Huber *et al.* are analogous art because they are concerned with a similar technical difficulty, namely the preparation of amine containing dispersants. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined polyoxyalkylene amines, as taught by Huber *et al.* in the invention of He, and would have been motivated to do so since Huber *et al.* suggests that such polyoxyalkylene amines provide dispersants provides reduced viscosity and increased gloss when used to formulate printing inks (¶ 10-11, 16).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 and 12-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5-11 of copending Application No. 12/090,505. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed compositions substantial overlap in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-10, and 12-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 11/718,026. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed compositions substantial overlap in scope. The R group of the instant application can be optionally substituted.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 14-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,197,877. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed dispersants overlap in scope. '877 does not claim a particulate solid or organic medium, however, a person having skill in the art would recognize the utility of a dispersant for dispersing pigments in liquid medium {ex, inks, paints, etc}.

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. See attached form PTO-892.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PEPITONE whose telephone number is (571)270-3299. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/
Supervisory Patent Examiner, Art Unit 1796

MFP
20-November-08